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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/816,635

04/02/2004

Robert Greer

0644-08

1050

29439 7590 04/29/2008

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VIRGINIA BEACH, VA 23452

EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,635	Applicant(s) GREER ET AL.	
	Examiner TAMRA L. DICUS	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02/08/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,12,14 and 26 is/are pending in the application.
- 4a) Of the above claim(s) 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-7,12 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The RCE is acknowledged.

The prior objections and 112 rejections are withdrawn due to Applicant's amendments.

Election/Restrictions

Newly submitted claim 26 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are directed to a method including *for* making a pre-bonded pavement marking grid and insert pattern is intended use and not in the originally presented article claims. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 26 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-6, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakazawa (US 5,238,721).

Nakazawa teaches claim 1. (Currently amended): A pre-bonded pavement marking grid and insert pattern comprising: an independent thermoplastic grid section (7/8, FIG. 1 and associated text, joint material 7 forming joint 8 is of elastic foamed resin material, having adjacent tiles therebetween and are in direct contact with adjacent sections forming an intersection 2:50-65), an independent and plurality of thermoplastic insert sections (6, FIG. 1 and associated text, 3:32-35, tiles of synthetic resin materials), wherein both sections have an adhesive layer (3:45-66, 4:1-10, synthetic resin or elastic rubber material embraces thermosetting and thermoplastic adhesive, claims 5-6), under to prevent the attached tiles from moving laterally and therefore bridging and bonding said intersection on the bottom of both layers and prevent dislodging or separation during transportation or handling, inherently both first and second sections define a top surface and a bottom surface. The joint material is applied to the tile beforehand, 2:55-60 and is thus considered prebonded. See also 3:1-10, 3:30-45, 4:1-9. Claims 1, 5-6, and 12 are met.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazawa (US 5,238,721) in view of Scharpf (US 5509715).

Nakazawa essentially teaches the claimed invention above.

Nakazawa does not expressly refer to the synthetic resin adhesives as thermosetting, thermoplastic, hot melt, or of the recited adhesives as per instant claim 7.

Scharpf teaches a flooring using adhesives for bonding purposes including thermosetting, thermoplastic, hot melt, and ethylene vinyl acetate (EVA) adhesives (6:24-45).

It would have been obvious to one having ordinary skill in the art to have modified the pavement marking of Nakazawa to include the adhesives as claimed because Scharpf teaches all the adhesives are suitable for bonding purposes in flooring or planks (3:25-35, 4:15-30, 6:24-462, Abstract, Scharpf).

To claim 14, because the same materials are employed, the softening point property is inherently expected.

Response to Arguments

Applicant's arguments filed 02/08/08 been fully considered but they are not persuasive.

Applicant argues that the grid and insert is in contact prior to laying on surface, however, it found that Nakazawa teaches the joint material 7 of joint 8 between adjacent tiles (equivalent in meaning to grid) is applied to the tile (insert) beforehand at 2:58-59. Moreover, applicant argues this step allows for spraying and intersection into a single moveable marking pattern, which steps are processes given little weight in product claims and a single moveable marking pattern is not claimed. The joint serves to elastically prevent the applied tiles from moving laterally of each other or lifting upward (2:56-68) and thus functions in the same way as Applicant in preventing movement from dislodging during transportation. Thus no differences are found.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tamra L. Dicus /TLD/
Examiner
Art Unit 1794

/Milton I. Cano/
Supervisory Patent Examiner, Art Unit 1794

4/14/08